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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,432	03/20/2001	Klaus Muller	732/000035	1490

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WASHINGTON, DC 20036

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/24/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,432

Applicant(s)

MULLER ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2/3. 6) ☐ Other:

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DETAILED ACTION

Response to Election

1. This action is in response to the provisional election mailed July 30, 2002.
(Group I) Claims 1-6 and 12-13 were provisionally elected rendering (Group II) Claims 7-11 to a non-elected species.

RESPONSE TO REQUEST FOR RECONSIDERATION

2. Applicant's election with traverse of method of making a layered composite material (Group II) is acknowledged. The traversal is on the ground(s) that 'claim 7 seems to be directed to the examiner's different process.' This is not true because claim 7 does not include extruded materials. The search of the 2 classes and subclasses would entail the requisite serious burden as the search for method of making is not the same as the article search. Additionally, the steps used in the method claims would not be expected to appear in the class/subclass of the product claims. Every layered composite material is not made using the same method steps.
The requirement is deemed proper and is therefore made **FINAL**.

Claim Rejections – 35 USC 112/USC 101

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 12-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12-13 provides for the use of the layered composite material, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 12-13 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections – 35 USC 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 4 rejected under 35 U.S.C. 102(b) as being anticipated by Nicholas et al (U.S. 3,668,034).

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7. Nicholas discloses a layered material comprising backing layer formed of thermoplastic material and an intermediate layer with an outer metalized film (abstract) where the layered material has an outer decorative layer (column 1, lines 7). Nicholas discloses the metallized film is made of chrome (column 1, line 41) having an intermediate layer formed of thermoplastic material (column 2, lines 3-4).

Claim Rejections – 35 USC § 103(a)

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholas et al (U.S. 3,668,034) in view of Vinod (U.S. 5,965,232).

11. Nicholas is relied upon for claims 1 and 4. Nicholas does not disclose a heat cured layer or the substrate made of polypropylene. Vinod teaches a layered composite material comprising a decorative layer, intermediate layer and lower layer coated with a protective coating (column 1, lines 39-41) where the coating is heat cured (column 5, lines 13-14) and the lower layer is made of polypropylene (column 7, lines 11-18). Nicholas and Vinod are analogous art because they are from the same field of layered thermoplastic material. It would have been obvious to one of ordinary skill in the art to include polypropylene in the substrate of Nicholas because Vinod teaches

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polypropylene to provide the multilayered composite with more protection from outside influences. Additionally it would have been obvious to one of ordinary skill in the art to include a heat cured layer because Vinod teaches the heat curing layer increases the original presentation of the multilayered decorative composite (column 5, lines 10-25) by protecting it from environmental hazards. Although neither reference specifically discloses the total thickness, thickness is an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering the optimum or workable range involves only routine skill in the art. The thickness directly affects durability of the composite material. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

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After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

